

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): William Y. Pong

Application No.: 10/721,386

Confirmation No.: 8062

Filed: 11/25/2003

Examiner: Marcus Charles

Art Unit: 2629

Title: BIDIRECTIONAL BELT TENSIONING APPROACH

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action of October 4, 2006, please amend this application as follows:

Applicant strongly traverses the Examiner's requirement under 35 USC 121 to elect a single disclosed Species. However, Applicant elects Species 3 as identified by the Examiner, which corresponds to Figure 4. Claims 1 - 7, 10 – 16, and 21 – 26 all read on Species 3. Further, Applicant notes that claims 1 – 3, 5, 6, 10 – 12, 14, 15, 21, 22, 24, and 25 are generic to all 5 species identified by the Examiner, and while the remaining claims may distinguish the individual species identified by the Examiner, they appear to be minor and should have little impact on the Examiner's searches.

Applicant traverses the Examiner's restriction for the following reasons.

- (1) The application contains a significant number of generic claims and does not contain an unreasonable number of species.
- (2) Regardless, the distinctions that do exist are such that no extra burden is placed upon the Examiner.

37 CFR § 1.146 states in pertinent part:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

37 CFR § 1.146 essentially states that there are two reasons the Examiner may use to require an election of species – (1) where the generic claims have been rejected or (2) where there is an unreasonable number of species. The Examiner has not yet rejected any of the generic claims and as Applicant has already stated, 14 of the 32 claims present in the application are generic to all 5 species identified by the Examiner. Therefore, the Examiner cannot require an election based upon the lack of an allowable generic claim. That leaves the presence of an unreasonable number of species as the basis for the Examiner's election requirement. The Examiner has identified 5 species based upon the 5 non-prior art Figures in the present application. However, the primary differences between these figures do not appear to justify the election required by the Examiner. The species (with respect to the 32 claims presented by Applicant) are as follows:

Figure 2 illustrates a belt tensioning device including two pulleys with a belt reeved about them and two linear springs, one connected to each pulley to tension the pulleys apart;

Figure 3 illustrates a belt tensioning device including two pulleys with a belt reeved about them and two torsional springs, one connected to each pulley to tension the pulleys apart;

Figure 4 illustrates a belt tensioning device connected to a drum of another device, the tensioning device including two pulleys with a belt reeved about them and one linear spring connected to one of the pulleys to tension the pulleys apart;

Figure 5 illustrates a belt tensioning device including two pulleys with a belt reeved about them and a spring connected to one of the pulleys to tension the pulleys apart; and

Figure 6 illustrates a belt tensioning device including two pulleys with a belt reeved about them and a spring connected to one of the pulleys to tension the pulleys apart.

The differences between these species are minor enough that there seems no purpose to a restriction between these species. While there are arguably 5 species and 5 species is arguably enough to require an election in some cases, such a situation does not exist here. Even if the Examiner maintains that the 5 species he has selected would be too burdensome to examine without an election, a selection of only one species is more than necessary given the similarity between the species. For example, Species 1 should be examined along with Species 3, given the relationship between the two as Species 3 is essentially Species 1 attached to another device, the only apparent difference being the absence of a second spring in the embodiment shown in Figure 4.

Other species are similar as well. Please consider the following comments.

First, any of current claims 1 – 32 that apply to the species disclosed in Figure 5 also apply to the species disclosed in Figure 6. As far as Applicant's claims go, they are the same species. Applicant understands that there are physical differences between the drawings, but since the claims are not focused on any of those differences, distinguishing them appears valueless. Therefore, Applicant is unsure why the Examiner would require an election between these species. If there were claims based upon the differences in the illustrations, Applicant could understand an election between the two species.

Second, Figures 2 and 3 appear to differ solely based upon the type of tensioning element used to separate the pulleys – linear springs vs. torsional springs. While these are correctly identified as different species, Applicant is surprised by the Examiner's requirement that an election between these species be made. Figures 5 and 6 illustrate the use of generic spring devices that could be either torsional or linear.

Third, as noted before, Figure 4 appears to show the tensioner of Figure 2 in the context of a larger device. However, Figure 4 only shows one linear spring tensioning mechanism.

Again, while arguably a different species, Applicant is surprised by the need to elect one of these over the other on the basis of one spring.

For each of the foregoing reasons reconsideration is respectfully requested.

Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

Joseph M. Young
Attorney for Applicants
Registration No. 45,248
Telephone (503) 685-4229
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JMY/rjh